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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,810	10/21/2003	Takeshi Natsuno	9683/159	4372

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EXAMINER

MILORD, MARCEAU

ART UNIT PAPER NUMBER

2618

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/689,810	NATSUNO, TAKESHI	
	Examiner	Art Unit	
	Marceau Milord	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 15 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6910624 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the removal of the features of a recording medium that is readable by an external device wherein said writer, when the recording medium protruded out of said mobile communication terminal is retracted inside said mobile communication terminal, deletes said selected data set written in said recording medium is not non-obvious over the claims of 6910624 B1, and therefore is not patentably distinct from each other.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling (US Patent No 6170745) in view of Matsumoto (US Patent No 6425522 B1).

Regarding claims 15, 19-21, Schilling discloses a mobile communication terminal that is served in a mobile communication network (figs. 4-6) and performs wireless communications, comprising: a housing having a slot; a memory (206 of fig. 5) in the housing configured to store a plurality of data sets, wherein each data set is associated with a card of a plurality of cards (col. 3, lines 19-34; col. 5, lines 36-63; col. 6, lines 7-34); a user interface coupled to the memory and configured to prompt a user to select a data set from the plurality of data sets (col. 6, lines 35-67); and an output interface coupled to and configured to read and output from said memory said selected data set (col. 7, lines 11-40; col. 7, line 56- col. 8, line 17; col. 9, lines 1-40).

However, Schilling does not specifically disclose the features of a recording medium that emulates the card associated with said selected data set, wherein said recording medium is permanently coupled to said slot and movable between retracted and protruding positions; and a writer configured to write said selected data set to said recording medium.

On the other hand, Matsumoto, from the same field of endeavor, discloses a processing apparatus for processing information contained in an IC card. When an application is newly registered in the IC card, registration of a corresponding service application program in the processing apparatus is required. Further, when applications stored in the IC card differ from those stored in the processing apparatus, a method of displaying names of the applications in a uniformized manner is required. In addition, an IC card read/write unit of the processing apparatus is made use of for registering service application programs in a memory incorporated in the processing apparatus, while the application names are registered in a memory area of the IC card in a common character code for allowing the names of the applications registered in the IC card to be displayed whenever occasion requires (col. 2, line 50- col. 3, line 40; col. 4, lines 2-

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57). The correspondence relations or correspondence table for all the applications available at that time should preferably be recorded or stored, and the correspondence table should be periodically down-loaded from an application list information management unit of the terminal apparatus installed in the central service station for updating constantly the table data to the latest one so that even the application data registered newly in the IC card (col. 17, lines 22-67). In addition, recording directly the application name in the IC card may identify the application name. In that case, all the application names recorded in the IC card can be read out in a uniformized manner by recording the application names in a common memory area in the IC card in a common form (col. 18, lines 2-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the technique of Matsumoto to the communication system of Schilling in order to provide an application program for installing application program in the IC card information processing apparatus.

Regarding claim 16, Schilling as modified discloses a mobile communication terminal that is served in a mobile communication network (figs. 4-6) and performs wireless communications, wherein each of said data sets includes information required for electronic-commerce transactions (col. 3, lines 8-34; col. 4, lines 36-58).

Regarding claim 17, Schilling as modified discloses a mobile communication terminal that is served in a mobile communication network (figs. 4-6) and performs wireless communications; wherein said information required for electronic-commerce transactions includes credit card information (col. 4, lines 18-63).

Regarding claim 18, Schilling as modified discloses a mobile communication terminal that is served in a mobile communication network (figs. 4-6) and performs wireless

communications; wherein each of said data sets includes information for identifying a user (col. 6, lines 23-67).

Regarding claim 23, Schilling as modified discloses a mobile communication terminal that is served in a mobile communication network (figs. 4-6) and performs wireless communications, wherein said mobile communication terminal is a mobile telephone for performing wireless telephone communications (col. 5, lines 36-63; col. 6, lines 7-22).

Claim 24 contains similar limitations addressed in claims 15, 19-20, and therefore are rejected under a similar rationale.

Regarding claims 25, 26-27, Schilling discloses a mobile communication terminal that is served in a mobile communication network (figs. 4-6) and performs wireless communications, comprising: a memory for storing card information items with regard to one or a plurality of cards; and an output interface for reading out from said memory said card information items so as to be output, wherein said output interface comprises: a magnetic medium that emulates the card (col. 3, lines 19-34; col. 5, lines 36-63; col. 6, lines 7-34; col. 7, lines 11-40; col. 7, line 56- col. 8, line 17; col. 9, lines 1-40).).

However, Schilling does not specifically disclose the features of a magnetic recording medium that emulates the card associated with said selected card information item to an external device, and a magnetic writer for reading out the card information selected by said selecting means from said memory to be written into said magnetic recording medium.

On the other hand, Matsumoto, from the same field of endeavor, discloses a processing apparatus for processing information contained in an IC card. When an application is newly registered in the IC card, registration of a corresponding service application program in the

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processing apparatus is required. Further, when applications stored in the IC card differ from those stored in the processing apparatus, a method of displaying names of the applications in a uniformized manner is required. In addition, an IC card read/write unit of the processing apparatus is made use of for registering service application programs in a memory incorporated in the processing apparatus, while the application names are registered in a memory area of the IC card in a common character code for allowing the names of the applications registered in the IC card to be displayed whenever occasion requires (col. 2, line 50- col. 3, line 40; col. 4, lines 2-57). The correspondence relations or correspondence table for all the applications available at that time should preferably be recorded or stored, and the correspondence table should be periodically down-loaded from an application list information management unit of the terminal apparatus installed in the central service station for updating constantly the table data to the latest one so that even the application data registered newly in the IC card (col. 17, lines 22-67). In addition, recording directly the application name in the IC card may identify the application name. In that case, all the application names recorded in the IC card can be read out in a uniformized manner by recording the application names in a common memory area in the IC card in a common form (col. 18, lines 2-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the technique of Matsumoto to the communication system of Schilling in order to provide an application program for installing application program in the IC card information processing apparatus.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marceau Milord whose telephone number is 571-272-7853. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Marceau Milord
Primary Examiner
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PRIMARY EXAMINER